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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/535,364	03/24/2000	Michael J. Comb	NEB-138-CIP	2664

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EXAMINER

PONNALURI, PADMASHRI

ART UNIT PAPER NUMBER

1627

DATE MAILED: 07/15/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/535,364

Applicant(s)  
Comb et al

Examiner  
Padmashri Ponnaluri

Art Unit  
1627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 3, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19, 21, 22, and 27-38 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 19, 21, 22, and 27-38 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### **DETAILED ACTION**

1. The amendment filed on 5/3/02 has been fully considered and entered into the application.
2. Claims 1-18, 20, 23-26 have been canceled, claims 19, 21-22 amended; and new claims 27-38 have been added by the amendment filed on 5/3/02.
3. Claims 1-, 21-22 and 27-38 are currently pending in this application.
4. The restriction mailed on 5/3/02 has crossed in the mail and since applicants have amended the claims ( and cancel some of the claims), a new restriction is provided to cover all the pending claims.

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, a dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Ph.D., Supervisory Patent Examiner at [jyothsna.venkat@uspto.gov](mailto:jyothsna.venkat@uspto.gov) or 703-308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

### ***Election/Restriction***

5. Restriction to one of the following inventions is required under 35 U.S.C. 121:

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Groups I-IV Claims 19 ( in part), 21, 22 (in part), drawn to a method for profiling modified protein levels or post transnational modification in a cell on a genome wide scale (the method uses the antibody of claim 27), classified in class 435, subclass 4.

**NOTE:** since the method uses antibody of claim 27, and the antibody of claim 27 comprises (group I) phosphorylated amino acid and the motif is either kinase consensus motif, or (group II) protein-protein binding motif; or (group III) acetylated aminoacid comprising motif; or (group IV) motif comprising methylated aminoacid.

- V. Claims 27 (in part), 28-29 (in part), 30-31, 32 (in part), 33-36, drawn to a motif specific, context independent antibody that binds a modified motif (kinase consensus) conserved among cell signaling proteins within genome, and said motif comprising phosphorylated amino acid, classified in class 530, subclass 387.1.
- VI. Claims 27 (in part), 28-29 (in part), 30-31, 32 (in part), 33, drawn to a motif specific, context independent antibody that binds a modified motif (protein-protein binding motif) conserved among cell signaling proteins within genome, and said motif comprising phosphorylated amino acid, classified in class 530, subclass 387.1.
- VII. Claims 27( in part), 37-38, drawn to to a motif specific, context independent antibody that binds a modified motif conserved among cell signaling proteins

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within genome, and said motif comprising acetylated amino acid, classified in class 530, subclass 387.1.

VIII. Claim 27 (in part), drawn to to a motif specific, context independent antibody that binds a modified motif conserved among cell signaling proteins within genome, and said motif comprising methylated amino acid, classified in class 530, subclass 387.1.

6. The inventions are distinct, each from the other because of the following reasons:

Inventions of groups I-IV and groups V-VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of different groups (groups V-VIII) can be used in either methods of groups I-IV. Thus the inventions are distinct.

7. Inventions of groups V-VIII are all drawn to different types of antibodies. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of groups V-VIII are drawn to different antibodies which differ from each other structurally and functionally. Thus restriction between the groups is proper.

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8. Inventions of groups I -IV are all drawn to different methods using different kinds of antibodies (groups V-VIII). Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of groups I-IV are drawn to method for profiling modified protein levels using different kinds of antibodies, which are distinct from each other. Thus the restriction between the groups is proper.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Some of the aforementioned groups are classified under same class or subclass, the corresponding non-patent literature search remains unaffected. Each of the identified groups require different searches. Therefore, restriction for examination purposes as indicated is proper.

10. This application contains claims directed to the following patentably distinct species of the claimed invention:

A) If group I is elected, applicants are requested to elect a single type of kinase consensus substrate motif.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 19, 21, 27-28, 30-33, 37-38 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CAR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CAR 1.143).

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CAR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CAR 1.48(b) and by the fee required under 37 CAR 1.17(I).

13. Applicant is required to reply to this restriction requirement within 30 days of mailing this action. See MPEP 809.2(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Ponnaluri whose telephone number is (703) 305-3884. The examiner is on *Increased Flex Schedule* and can normally be reached on Monday to Friday from 7.00 AM to 3.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, Ph.D., can be reached on (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

P. Ponnaluri  
Patent Examiner  
Technology Center 1600  
Art Unit 1627  
10 July 2002

  
**PADMASHRI PONNALURI**  
**PRIMARY EXAMINER**